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| PERKINS COIE LLP | | | EXAMINER | |
| P.O. BOX 2168 | | | MISIASZEK, MICHAEL | |
| MENLO PARK, CA 94026 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/733,830

Applicant(s)

HEINS, DOUGLAS B.

Examiner

MICHAEL MISIASZEK

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-16, 19-27 and 29-73 is/are pending in the application.
- 4a) Of the above claim(s) 29-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-16 and 19-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/17/2007 has been entered.

Response to Amendment

Applicant's amendments filed 12/17/2007 have been received and reviewed. The status of the claims is as follows:

Claims 1, 4-16, 19-27 and 29-73 are pending. Claims 29-73 have previously been withdrawn from consideration by the applicant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 4, 5, 10, 12, 13, 17, 19 and 20-26 are rejected under 35 U.S.C.

103(a) as being unpatentable over Berarducci in view of Reed, Mauro, and Rosen.

Regarding Claim 1

Berarducci discloses a computer implemented method for performing the business of placing a digital image processing and fulfillment order via a communications network comprising:

- identifying a user (at least paragraph [0025]: user account)
- acquiring an at least one digital image captured by a digital imaging device (at least abstract)
- associating profile, personalization and customization aspects to said identified user into a user provisioner (at least paragraph [0040]: user service account options)
- said profile aspects include a user address, a user contact information, and a user billing information (at least figure 5A)

- said personalization aspects include a choice of digital photography enhancement (at least paragraph [0043]: addition of time stamp), a choice of automated rendering (at least paragraph [0044]: selection of size), a choice of digital photography layout (at least figures 3-4: matte, background, etc.), a choice of digital photography fulfillment presentation (at least paragraph [0041]: standard prints, album, etc..)
- said customization aspects include a physical hardcopy fulfillment (at least paragraph [0016]: image printing), a choice of vendor for hardcopy fulfillment (at least paragraph [0062]: retail kiosk chosen), and a choice of hardcopy fulfillment or other non-physical means of taking delivery (at least paragraph [0062]: prints delivered to kiosk or directly to customer)
- automatically performing a single-event instantiation process which completes a user request, said single-event instantiation process including sending a processing and fulfillment order along with the user provisioner to a plurality of system components, the plurality of system components operating to fulfill said user request (at least paragraph [0033]: user places an order, which uses service account)
- wherein the step of automatically performing a single-event instantiation process is the result identification of the user and acquisition said at least one digital image (at least paragraph [0038] and abstract: login and picture acquisition)
- wherein the user is a single user and the information regarding the user is captured dynamically and additional information augments the dynamic user

information during the single-event instantiation of a processing and fulfillment order (at least paragraph [0040]: user account information augmented)

- receiving said user request under control of a single-event instantiation of a plurality of processing and fulfillment system components (at least paragraph [0033]: user places order)
- retrieving the provisioner associated with said identified user (at least paragraph [0033]: user places an order, which uses service account)
- determining payment and authorization methods using said user provisioner
- retrieving a fulfillment delivery method using said user provisioner (at least paragraph [0039]: delivery information)
- providing for user personalization and customization of the order processing and fulfillment workflow using said user provisioner (at least paragraph [0041]: preferred fulfillment times)
- fulfilling said processing and fulfillment order to complete processing and fulfillment of the single-event instance (at least paragraph [0041]: order fulfilled)
- whereby the processing and fulfillment order is completed without using a software application, a web online service, or a traditional shopping cart ordering model (at least paragraph [0037]: order fulfilled through ground mail)

Berarducci does not explicitly disclose:

- a preferred means of notification
- the user does not need to explicitly, directly or indirectly, specify operations, manipulations or enhancements on the at least one digital image, either singularly or as a group or collection, when placing a processing and fulfillment order
- the entire single-event instantiation of a processing and fulfillment order offers a preview of the entire processing and fulfillment workflow to verify and validate that all options are valid and available as specified by the user provisioner

Reed teaches that it is known to include a preferred means of notification (at least paragraph [0136]: user's preference for notification) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method, as taught by Berarducci, with the notification preference, as taught by Reed, since such a modification would have provided increased control for a consumer in a transaction system through personalized preferences (at least paragraph [0210] of Reed). Further, the cited references are analogous art and the combination recited only unites elements of the cited references as detailed above, with no change in their respective functions and which yield predictable results. Thus, the subject matter claimed would have been obvious under *KSR*. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Mauro teaches that it is known to include providing for a user to not have to explicitly specify operations on digital images (at least paragraph [0018]: default photofinishing options for user) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method, as taught by Berarducci and Reed, with the default options of Mauro, since such a modification would have provided a means of minimizing necessary customer interaction with a photofinishing service (at least paragraph [0004] of Mauro). Further, the cited references are analogous art and the combination recited only unites elements of the cited references as detailed above, with no change in their respective functions and which yield predictable results. Thus, the subject matter claimed would have been obvious under *KSR*. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Rosen teaches that it is known to include a preview of the workflow options of an order (at least figure 11B: user can go back to change options if desired) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method, as taught by Berarducci and Reed, with the workflow preview, as taught by Rosen, since such a modification would have provided a means to allow consumers to easily and conveniently purchase merchandise personalized to their own tastes (at least paragraph [0004] of Rosen). Further, the cited references are analogous art and the combination recited only unites elements of the cited references as detailed above, with no change in their respective functions and which yield predictable results. Thus, the subject matter claimed would have been obvious under *KSR*. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Regarding Claims 4, 5, 10, 13, 20-26

Berarducci discloses:

- wherein user identification involves entry of user id and password in a single-event instantiation (at least paragraph [0007]: password and user id login)
- wherein user identification involves an email address and password in a single-event instantiation (at least paragraph [0007]: password and email address login)
- wherein the acquisition of digital images is made via a direct cable link to the digital imaging device (at least paragraph [0029]: cable connection)
- wherein the digital imaging device is a digital still camera device (at least paragraph [0029]: Kodak digital camera)
- wherein the client system and the plurality of system components communicate via a Wide Area Network such as the Internet (at least paragraph [0016])
- wherein the client system and the plurality of system components communicate via a secure connection utilizing encryption for those portions of the processing and fulfillment order for which security and privacy are desired (at least paragraph [0040])
- wherein the client system connects to a plurality of system components comprising:
 - a) under control of an individual system component, the means to receive a processing and fulfillment order from either a client system or from

- another system component (at least paragraph [0041]: fulfillment center receives order)
- b) and, within each system component contain the necessary computing resources to locate additional information needed to execute their individual affects on the processing and fulfillment order (at least paragraph [0033]: database obtains billing information)
 - c) and, within each system component contain the necessary computing resources to access and augment the user provisioner needed to execute their individual affects on the processing and fulfillment order and update the provisioner as necessary to reflect the system component is complete (at least paragraph [0040]: information augmented)
 - wherein the system components can serve multiple purposes in completing one or more aspects of the processing and fulfillment order (at least paragraphs [0033] and [0041]: database and fulfillment center)
 - wherein the system components can process multiple single-event instantiations of the user request processing and fulfillment order, each mutually independent from each other (at least paragraph [0063]: system can handle multiple orders from one user)
 - wherein one system component is a server offering one or more different processing and fulfillment behaviors (at least paragraph [0016]: system is on Internet, therefore having a server that can complete separate tasks)

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- wherein one system component is user email account displaying an email information message pertinent to the user request processing and fulfillment order status (at least paragraph [0058]: email to user account)

Regarding Claim 12

Berarducci teaches the claimed invention except for:

- the acquisition of digital photographs uses a digital media memory card reader.

Mauro teaches that it is known to include acquiring digital photographs using a digital media memory card reader (at least abstract) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method, as taught by Berarducci and Reed, with memory card reader of Mauro, since such a modification would have provided a means of minimizing necessary customer interaction with a photofinishing service (at least paragraph [0004] of Mauro). Further, the cited references are analogous art and the combination recited only unites elements of the cited references as detailed above, with no change in their respective functions and which yield predictable results. Thus, the subject matter claimed would have been obvious under *KSR*. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Regarding Claim 19

Berarducci teaches the claimed invention except for:

- the presentation of information captured during a preview of the entire processing and fulfillment workflow permits the user to fine-tune choices and options prior to final commitment

Rosen teaches that it is known to include a preview of the workflow options of an order, in which the options can be fine-tuned (at least figure 11B: user can go back to change options if desired) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method, as taught by Berarducci and Reed, with the workflow preview, as taught by Rosen, since such a modification would have provided a means to allow consumers to easily and conveniently purchase merchandise personalized to their own tastes (at least paragraph [0004] of Rosen). Further, the cited references are analogous art and the combination recited only unites elements of the cited references as detailed above, with no change in their respective functions and which yield predictable results. Thus, the subject matter claimed would have been obvious under *KSR*. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

3. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berarducci and Reed, Mauro, and Rosen, as applied to claim 1 above and further in view of Ramachandran.

Berarducci, Reed, Mauro, and Rosen teaches the claimed invention except for:

- user identification is a credit card/ATM swipe in a single-event instantiation
- user identification in a single-event instantiation is enabled through a smart chip enabled device
- user identification in a single-event instantiation is enabled through a biometric identification

Ramachandran teaches that it is known to include user identification by a credit card swipe, a smart chip enabled device, and biometric identification (at least paragraph [0048]: obtaining of user's account information) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method taught by Berarducci, Reed, Mauro, and Rosen with the user identification techniques, as taught by Ramachandran, since such a modification would have provided a means of associating a fee for the distribution of digital content (at least paragraph [0018] of Ramachandran). Further, the cited references are analogous art and the combination recited only unites elements of the cited references as detailed above, with no change in their respective functions and which yield predictable results. Thus, the subject matter claimed would have been obvious under *KSR*. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berarducci Reed, Mauro, and Rosen, as applied to claim 1 above and further in view of House.

Berarducci, Reed, Mauro, and Rosen teaches the claimed invention except for:

- the single-event instantiation of user identification is a self mailer/drop-off mailer model

House teaches that it is known to include using a self mailer/drop-off mailer model (at least paragraph [0073]) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method, as taught by Berarducci, Reed, Mauro, and Rosen, with the self mailer model, as taught by House, since such a modification would have provided a means for offering the best delivery options based on user input (at least paragraph [0073] of House). Further, the cited references are analogous art and the combination recited only unites elements of the cited references as detailed above, with no change in their respective functions and which yield predictable results. Thus, the subject matter claimed would have been obvious under *KSR*. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

5. Claims 11, 14, 15, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berarducci, Reed, Mauro, and Rosen, as applied to claim 1 above and further in view of Paul.

Berarducci, Reed, Mauro, and Rosen teaches the claimed invention except for:

- the acquisition of digital images is made via a wireless link to the digital imaging device
- the digital imaging device is a digital video camera device
- the digital imaging device is a mobile radiotelephone device
- one system component is a user text messaging account destination displaying information pertinent to the user request processing and fulfillment order

Paul teaches that it is known to include acquiring digital images via a wireless link (at least abstract), the digital image device being a digital video camera device (at least paragraph [0019] or a mobile radiotelephone device (at least paragraph [0032]: camera phone), and a user text messaging account destination displaying information pertinent to the order (at least paragraph [0036]: SMS) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method, as taught by Berarducci, Reed, Mauro, and Rosen, with the wireless link, digital imaging devices, and text messaging, as taught by Paul, since such a modification would have provided a means for users to have limitless developed pictures without running out of film (at least paragraph [0025] of Paul). Further, the cited references are analogous art and the combination recited only unites

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elements of the cited references as detailed above, with no change in their respective functions and which yield predictable results. Thus, the subject matter claimed would have been obvious under *KSR*. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berarducci, Reed, Mauro, and Rosen, as applied to claim 1 above and further in view of Chauvin.

Berarducci, Reed, Mauro, and Rosen teaches the claimed invention except for:

- the digital imaging device is a portable digital assistant computing device with digital camera extension.

Chauvin teaches that it is known to include a portable digital assistant with a digital camera extension as a digital imaging device (at least paragraph [0051]) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method as taught by Berarducci, Reed, Mauro, and Rosen, with the personal digital assistant with digital camera extension, as taught by Chauvin, since such a modification would have provided a means for various types of entities to be used for imaging services (at least paragraph [0008] of Chauvin). Further, the cited references are analogous art and the combination recited only unites elements of the cited references as detailed above, with no change in their respective functions and which yield predictable results. Thus, the subject matter claimed would have been obvious under *KSR*. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Response to Arguments

Applicant's arguments with respect to Berarducci have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., modifying the image's color and brightness information, edge enhancement or blurring, red eye reduction, ignore over-developed or under-developed photographs, image rotation) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, even if the features were recited in the present claims, for the sake of argument, applicant's remarks have set forth that the various features are old and well known in the art. Accordingly, it would have been obvious to one of ordinary at the time of the invention to have modified Berarducci to have included the various old and well known features.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL MISIASZEK whose telephone number is (571)272-6961. The examiner can normally be reached on 9:00 AM - 5:30 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Smith/
Supervisory Patent Examiner, Art
Unit 3625

Michael A. Misiaszek
Patent Examiner
5/26/2008

Application Number**Application/Control No.**

10/733,830

**Applicant(s)/Patent under
Reexamination**

HEINS, DOUGLAS B.

Examiner

MICHAEL MISIASZEK

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